



UNITED STATES PATENT AND TRADEMARK OFFICE

6A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,313	10/15/2003	Kevin Baerwalde	043629.002	7246

25461 7590 09/11/2006

SMITH, GAMBRELL & RUSSELL
SUITE 3100, PROMENADE II
1230 PEACHTREE STREET, N.E.
ATLANTA, GA 30307-3592

EXAMINER

PHAM, HUONG Q

ART UNIT PAPER NUMBER

3743

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,313	Applicant(s) BAERWALDE ET AL.	
	Examiner Huong Q. Pham	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-8, 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note that the use of the Trademarks in claim 8 renders the scope of the claims indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4 – 6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepera (6,499,485) in view of Hung (5,531,666).

As for claim 1, Pepera teaches a device comprising an outer shell (figure 3) made of plastic material , a plurality of protuberances extending outwardly from said outer shell (note figure 3 with plurality of protuberances) and a central core, wherein

said central core is substantially filled with a substance, said substance is capable of being permanently sealed (capable of not being removed , if desired) within the central core.

Hung teaches a device with an outer shell which is substantially ellipsoid with plurality of protuberances . In view of the teaching of Hung ,it would have been obvious to one ordinary skill in the art at the time the invention was made to make the device of Pepera an ellipsoid outer shell shape and with protuberances extending outwardly from the outer shell in order to achieve the desired massaging effect.

As for claim 10, note the plurality of protuberances extending outwardly from said outer shell (note figure 3 of Pepera).

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepera (6,499,485) in view of Hung 9 5,531,666), and further in view of Pelton et al (4,745,909) and Hardy et al (5,693,624).

Perlon et al teaches the use of gel material inside a massaging tool. Hardy et al teaches a gel with glycol inside a tube or package for treatment. In view of the teachings of Perlon et al and Hardy et al , it would have been obvious to one ordinary skill in the art at the time the invention was made to provide the device of Pepera with a gel material containing glycol in order to provide the desired massaging or therapeutic effect.

Applicant's arguments filed 6/22/2006 have been fully considered but they are not persuasive.

Applicant argues that " there are no protuberances that extend from the smooth curved outer surface of shell of Pepera....". The examiner does not agree. Note in figure 3 of Pepera that the device has at least 3 protuberances that extend from the smooth curved (the outer surface of the cylinder portion is curved) outer surface of shell of Pepera .

Applicant argues that " there is no motivation to combine Pepera with Hung.....". The examiner does not agree. Note that motivation to combine is well expressed in the previous Office Action. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the patent to Hung was relied upon to teach a massaging device with ellipsoidal shape with protuberances. In view of the teaching of Hung ,it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the massaging device of Pepera , or any massaging device, an ellipsoidal shape having protuberances extending outwardly from the outer shell in order to achieve the desired massaging effect. Note that the modification of the shape of a massaging device, based on a well-

known shape of a massaging device in the art in order to provide the well-known massaging effect on the body of a user, is well within the realm of one ordinary skill in the art, and does not provide any unobvious result, and therefore is not patentable over prior art. As regards claim 8, applicant argues that " names used in trade are permissible in patent application....." . Note that while the use of a Trademark is permissible in patent application, the use of a Trademark in the claim(s) renders the claim(s) indefinite because the scope of the claim(s) is unclear.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

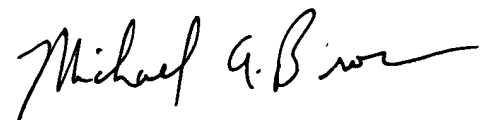
Art Unit: 3743

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272 - 4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 1, 2006

A handwritten signature in black ink, appearing to read "Michael A. Brown". The signature is fluid and cursive, with a long horizontal stroke at the end.

MICHAEL A. BROWN
PRIMARY EXAMINER